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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/759,966	01/16/2004	Jordi Albornoz	POU920030137US1	8190
23334 7590 02/24/2009 FLETT GIBBONS GUTMAN BONGINI & BIANCO P.L. ONE BOCA COMMERCE CENTER 551 NORTHWEST 77TH STREET, SUITE 111 BOCA RATON, FL 33487				
EXAMINER MADAMBA, CLIFFORD B				
ART UNIT 3696		PAPER NUMBER		
NOTIFICATION DATE 02/24/2009		DELIVERY MODE ELECTRONIC		

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/759,966
Filing Date: January 16, 2004
Appellant(s): ALBORNOZ, JORDI

Stephen Bongini
Reg. No. 40,917
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10 March 2008 appealing from the Office action mailed 06 September 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows.

NEW GROUND(S) OF REJECTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent a method claim must (1) be tied to a particular machine or apparatus or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)). A method claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here claims 1-9 fail to meet the above requirements since there is not a sufficient tie to another statutory class.

Claim Rejections – 35 USC § 112

Claim 1 and corresponding dependent claims 8-9 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant's claimed limitations do not adequately describe the structure of the device. As such, it is necessary to clarify where the computer implementation takes place. The body of the claims does not contain any limitations indicating the structure of the device. A system or an apparatus claim should always claim the structure or the hardware that performs the function. Appropriate correction is required.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

U.S. Patent 6,493,685 Ensel 2-1999

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

NEW GROUND(S) OF REJECTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent a method claim must (1) be tied to a particular machine or apparatus or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)). A method claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here claims 1-9 fail to meet the above requirements since there is not a sufficient tie to another statutory class.

Claim Rejections - 35 USC § 112

Claim 1 and corresponding dependent claims 8-9 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant's claimed limitations do not adequately describe the structure of the device. As such, it is necessary to clarify where the computer implementation takes place. The body of the claims does not contain any limitations indicating the structure of the device. A system or an apparatus claim should always claim the structure or the hardware that performs the function. Appropriate correction is required.

Claim Rejections – 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this office action:

A person shall be entitled to a patent unless –

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Ensei et al., U.S. Patent 6,493,685.

As per claim 1 (currently amended), Ensei teaches a method for providing automatic recurring online payments, the method comprising the steps of:

- *receiving, from a user, an automatic recurring online payment configuration that includes an amount and interval for executing a plurality of automatic recurring payments [see at least column 10, lines 21-49 and column 12, lines 43-47];*
- *determining that one of the automatic recurring payments is to be executed based on the automatic recurring online payment configuration [see at least column 10, lines 21-49];*
- *in response to determining that one of the automatic recurring payment is to be executed, sending a notification to the user to notify the user that one automatic recurring payment is to be executed, the notification being sent to the user before the one automatic recurring payment is executed [see at least column 10, lines 36-39];*
- *determining whether or not to execute the one automatic recurring payment based on at least one of a response to the notification received from the user and a lack of a response to the notification from the user within a specified period of time [see at least column 7, lines 61-64; column 12, lines 54-67; column 14, lines 57-59].*

As per claim 2 (currently amended), Ensel teaches the method of claim 1 as described above. Ensel further teaches the limitation *wherein the automatic recurring online payment configuration further includes a source account for the automatic recurring payments, a recipient of the automatic recurring payments, and at least one payment date [see at least column 11, lines 54-60].*

As per claim 3 (original), Ensel teaches the method of claim 1 as described above. Ensel further teaches the limitation *wherein the notification comprises at least one of an email message and an instant message [see at least column 14, lines 30-34].*

As per claim 4 (currently amended), Ensel teaches the method of claim 1 as described above. Ensel further teaches the limitation *wherein the determining step of determining whether or not to execute the one automatic recurring payment comprises the sub-steps of: receiving the response to the*

notification from the user; and if the response from the user authorizes the one automatic recurring payment, executing the one automatic recurring payment according to the automatic recurring online payment configuration [see at least column 8, lines 60-66; column 7, lines 61-64].

As per claim 5 (currently amended), Ensel teaches the method of claim 4 as described above. Ensel further teaches the limitation *wherein the step of determining whether or not to execute the one automatic recurring payment further comprises the sub-step of: if the response from the user modifies the one automatic recurring payment, executing the one automatic recurring payment as modified [see at least column 8, lines 60-66; column 7, lines 61-64].*

As per claim 6 (currently amended), Ensel teaches the method of claim 4 as described above. Ensel further teaches the limitation *wherein the step of determining whether or not to execute the one automatic recurring payment further comprises the sub-step of: if the response from the user suspends the automatic recurring payments, suspending two or more of the automatic recurring payments [see at least column 8, lines 60-66; column 7, lines 61-64].*

As per claim 7 (currently amended), Ensel teaches the method of claim 4 as described above. Ensel further teaches the limitation *wherein the step of determining whether or not to execute the one automatic recurring payment further comprises the sub-step of: if the response from the user cancels the one automatic payment, canceling the one automatic recurring payment [see at least column 8, lines 60-66; column 7, lines 61-64].*

As per claim 8 (currently amended), Ensel teaches the method of claim 1 as described above. Ensel further teaches the limitation *wherein in the step of determining whether or not to execute the one automatic recurring payment, if a response to the notification is not received from the user within the specified period of time, it is determined to execute the one automatic payment [see at least column 7, lines 61-64; column 12, lines 54-67; column 14, lines 54-59].*

As per claim 9 (currently amended), Ensel teaches the method of claim 1 as described above. Ensel further teaches the limitation wherein in the step of determining whether or not to execute the one automatic recurring payment, if a response to the notification is not received from the user within the specified period of time, it is determined to suspend the automatic recurring payments or cancel the one automatic recurring payment [see at least column 7, lines 61-64; column 12, lines 54-67; column 14, lines 54-59].

As per claim 10 (currently amended), Ensel teaches a computer readable medium encoded with a program for providing automatic recurring online payments, the program comprising instructions for execution by a processing circuit for performing the steps of:

- receiving, from a user, an automatic recurring online payment configuration that includes an amount and an interval for executing a plurality of automatic recurring payments [see at least column 10, lines 21-49 and column 12, lines 43-47];
- determining that one of the automatic recurring online payments is to be executed based on the automatic recurring online payment configuration [see at least column 10, lines 21-49];
- in response to determining that the one automatic recurring payment is to be executed, sending a notification to the user to notify the user that one automatic recurring payment is to be executed, the notification being sent to the user before the one automatic recurring payment is executed [see at least column 10, lines 36-39];
- determining whether or not to execute the one automatic recurring payment based on at least one of a response to the notification received from the user and a lack of a response to the notification from the user within a specified period of time [see at least column 7, lines 61-64; column 12, lines 54-67; column 14, lines 57-59].

As per claim 1.1 (currently amended), Ensel teaches the computer readable medium of claim 10 as described above. Ensel further teaches the limitation *wherein the notification comprises at least one of an email message and an instant message* [see at least column 14, lines 30-34].

As per claim 1.2 (currently amended), Ensel teaches the computer readable medium of claim 10 as described above. Ensel further teaches limitation *wherein the step of determining whether or not to execute the one automatic recurring payment comprises the sub-steps of: receiving the response to the notification from the user; and if the response from the user authorizes the one automatic recurring payment, executing the one automatic recurring payment according to the automatic recurring online payment configuration* [see at least column 8, lines 60-66; column 7, lines 61-64; column 11, lines 66-67].

As per claim 1.3 (currently amended), Ensel teaches the computer readable medium of claim 12 as described above. Ensel further teaches the limitation *wherein the step of determining whether or not to execute the one automatic recurring payment further comprises the sub-step of: if the response from the user modifies the one automatic recurring payment, executing the one automatic recurring payment as modified* [see at least column 8, lines 60-66; column 7, lines 61-64].

As per claim 1.4 (currently amended), Ensel teaches the computer readable medium of claim 12 as described above. Ensel further teaches the limitation *wherein the step of determining whether or not to execute the one automatic recurring payment further comprises the sub-steps of: if the response from the user suspends the automatic recurring payments, suspending two or more of the automatic recurring payments; and, if the response from the user cancels the one automatic recurring payment, canceling the one automatic recurring payment* [see at least column 8, lines 60-66; column 7, lines 61-64].

As per claim 1.5 (currently amended), Ensel teaches the computer readable medium of claim 10 as described above. Ensel further teaches the limitation *wherein in step of determining whether or not to*

execute the one automatic recurring payment, if a response to the notification is not received from the user within the specified period of time, it is determined to execute the one automatic recurring payment [see at least column 7, lines 61-64; column 12, lines 54-67; column 14, lines 54-59].

As per claim 15 (currently amended), EnseI teaches the computer readable medium of claim 10 as described above. EnseI further teaches the limitation wherein in the step of determining whether or not to execute the one automatic recurring payment, if a response to the notification is not received from the user within the specified period of time, it is determined to suspend the automatic recurring payments or cancel the one automatic recurring payment [see at least column 7, lines 61-64; column 12, lines 54-67; column 14, lines 54-59].

As per claim 17 (currently amended), EnseI teaches a computer system for providing automatic recurring online payments, the computer system comprising:

- a receiver receiving, from a user, an automatic recurring online payment configuration that includes an amount and an interval for executing a plurality of automatic recurring payments [see at least column 10, lines 21-49 and column 12, lines 43-47];
- a processor determining that one of the automatic recurring payments is to be executed based on the automatic recurring online payment configuration [see at least column 14, lines 54-61];
- a transmitter sending, in response to determining that the one automatic recurring payment is to be executed, a notification to the user to notify the user that the one automatic recurring payment is to be executed, the notification being sent to the user before the one automatic recurring payment is executed [see at least column 8, lines 14-15];
- wherein the [a] processor determines whether or not to execute the one automatic recurring payment based on at least one of a response to the notification received from the user and a lack

of a response to the notification from the user within a specified period of time [see at least column 7, lines 61-64; column 14, lines 57-59];

As per claim 18 (currently amended), Ensel teaches the computer system of claim 17 as described above. Ensel further teaches the limitation *wherein the response to the notification is received from the user, and if the response from the user authorizes the one automatic recurring payment, the processor executes the one automatic recurring payment according to the automatic recurring online payment configuration [see at least column 8, lines 60-66; column 7, lines 61-64; column 11, lines 66-67].*

As per claim 19 (currently amended), Ensel teaches the computer system of claim 18 as described above. Ensel further teaches the limitation *wherein if the response from the user modifies the one automatic recurring payment, the processor executes the one automatic recurring payment as modified [see at least column 8, lines 60-66; column 7, lines 61-64].*

As per claim 20 (currently amended), Ensel teaches the computer system of claim 19 as described above. Ensel further teaches the limitation *wherein if the response from the user suspends the automatic payments, the processor suspends two or more of the recurring payments, and if the response from the user cancels the one automatic recurring payment, the processor cancels the one automatic recurring payment [see at least column 8, lines 60-66; column 7, lines 61-64].*

(10) Response to Argument

Claims 1, 10 and 17

With regard to the claims above, Appellant selects independent claim 1 as representative of the independent claims on appeal and makes the following arguments:

Appellant argues that the Ensel reference does not teach or suggest the step wherein in response to determining that the one automatic recurring payment is to be executed, sending a notification to the user to notify the user that the one automatic recurring payment is to be executed, the notification being sent to the User before the one automatic recurring payment is executed.

The Office respectfully disagrees, and maintains that the prior art references, used in rejecting the claims, clearly and expressly discloses all the recited features of the claims, as currently presented, and that Applicant has misinterpreted and/or not fully considered all the teachings and disclosures of the prior arts of record.

Ensel discloses as his invention an electronic account presentation and response system and method. The invention generally relates to the publishing of electronic information to consumers and for processing consumer's responses and more particularly to a system and method for presenting electronic bills to consumers and for processing consumer payments. An Information Interface Provider (IIP) acts as the interface between a biller and its customers for both the presentment of electronic bills to the customers and for the processing of payments from the biller's customers in response to specific instructions provided by the customers. As such, the teachings of Ensel are found in a field of endeavor, which, while not unrelated, is also within the scope and reasoning of one of ordinary skill in the art.

The 06 September 2007 points to Ensel, which recites:

"For Example, two of the monthly bills typically paid by most consumers are telephone and utility bills" [see at least col. 2, lines 51-52].

"In its central function, the Information Interface Provider (IIP) creates and publishes bills to the biller's customers in response to data provided by the biller and processes the payments in response to instructions provided by the customers" [see at least col. 3, lines 55-59].

"Each customer has its own selected preference(s) for the channel on which the bill is to be presented" [see at least col. 4, lines 32-33].

"Furthermore, the IIP must be able to track preauthorized payments of certain bills by customers. Using preauthorization, the consumer may authorize the IIP to debit a preselected consumer account with respect to certain bills, typically recurring bills for the same amount, e.g., a mortgage payment" [see at least col. 4, lines 46-51].

"Additionally, customer service data includes customer [80] address changes as well as status and preference changes related to customers [80]. For example, a customer [80] might have been paying bills manually (i.e., reviewing the bill and initiating the payment of the bill after its review). At some point, the customer [80] might decide that he or she would like to have this bill paid automatically every month" [see at least col. 7, lines 25-31].

"In one embodiment of the present invention, the mechanism for effecting the customer's payment is included in the Email message, for example code which creates a "pay the bill" type button... Alternatively, the Email message sent to the customer contains code which enables the customer to formulate its payment instructions which are then encrypted and sent back to the IIP [20] in a return Email message" [see at least col. 8, lines 57-66].

The Enrollment database [205] contains all of the information relevant to the customers [80] of the biller [5]. Examples of the type of information included in Enrollment database [205] includes, but is not limited to: ...a preferred presentment vehicle (channel of distribution) and alternate presentment vehicles; customer presentment preferences (e.g., present my bill as soon as available, at the end of the month, exception presentment (only present my bill if dollar amount exceeds a limit, otherwise automatically pay the bill...); ...reminder preferences (e.g., as soon as possible, at end of month, 5 days before due date, on due date, 5 days late, no reminder...);

...payment preferences (e.g., preauthorized, on due date, at end of month, full or fixed amount, automatic within limit)..." [see at least col. 10, lines 21-49].

"After having opportunity to review its bill, a customer [80] can initiate the payment process..."
[see at least col. 17, lines 41-42].

It is apparent from the description in the above disclosures (i.e., "typically recurring bills", "enabling the customer to formulate payment instructions", "reminder preferences", "payment preferences", etc.), that Ensel is clearly directed towards notifying a customer or user that an automatic recurring payment is scheduled to be executed, the notification being sent to the user prior to the automatic recurring payment being executed. The limitation for the claim above as written, does not differentiate from the disclosure described above and is therefore interpreted broadly. As such, the rejection with regard to the above argument with regard to Ensel should be maintained accordingly.

Appellant further argues that the Ensel reference does not teach or suggest the step comprising determining whether or not to execute the one automatic recurring payment based on at least one of a response to the notification received from the user and a lack of a response to the notification from the user within a specified period of time.

The Office respectfully disagrees, and maintains that the prior art references, used in rejecting the claims, clearly and expressly discloses all the recited features of the claims, as currently presented, and that Applicant has misinterpreted and/or not fully considered all the teachings and disclosures of the prior arts of record.

The 06 September 2007 points to Ensel, which recites:

"In one embodiment of the present invention, the mechanism for effecting the customer's payment is included in the Email message, for example code which creates a "pay the bill" type

button... Alternatively, the Email message sent to the customer contains code which enables the customer to formulate its payment instructions which are then encrypted and sent back to the IIP [20] in a return Email message" [see at least col. 8, lines 57-66].

It is apparent based on the disclosure above, that the system, by informing or notifying the customer or user of a due payment and providing the customer with the option to respond through a response mechanism (e.g., "pay the bill" type button), is carrying out the function of determining whether it can go ahead and process the payment based on the response provided by the customer to its notification. As such, the limitation above as argued by Appellant, is clearly taught by the cited reference.

In addition, Ensel further recites:

The Enrollment database [205] contains all of the information relevant to the customers [80] of the biller [5]. Examples of the type of information included in Enrollment database [205] includes, but is not limited to: ...a preferred presentment vehicle (channel of distribution) and alternate presentment vehicles; customer presentment preferences (e.g., present my bill as soon as available, at the end of the month, exception presentment (only present my bill if dollar amount exceeds a limit, otherwise automatically pay the bill...); ...reminder preferences (e.g., as soon as possible, at end of month, 5 days before due date, on due date, 5 days late, no reminder...); ...payment preferences (e.g., preauthorized, on due date, at end of month, full or fixed amount, automatic within limit)..." [see at least col. 10, lines 21-49].

Clearly, based on the varying options or preferences provided to the customer pertaining to how or when he or she wants to be notified of a pending payment, the above disclosure illustrates the system carrying out the function of determining whether or not to execute or process a payment based on a response or instruction from the customer upon receipt of the notification. The limitation for the claim above as written, does not differentiate from the disclosure described above and is therefore

interpreted broadly. As such, the rejection with regard to the above argument with regard to Ensel should be maintained accordingly.

Appellant further argues that the Ensel reference only teaches sending a bill notification to a user, and does not teach sending a notification that an automatic recurring payment is to be executed.

The Office respectfully disagrees, and maintains that the prior art references, used in rejecting the claims, clearly and expressly discloses all the recited features of the claims, as currently presented, and that Applicant has misinterpreted and/or not fully considered all the teachings and disclosures of the prior arts of record.

The 06 September 2007 points to Ensel, which recites:

"...examples of the type of information included in the enrollment database includes, but is not limited to: ...payment preferences (e.g., preauthorized, on due date, at end of month, full or fixed amount, automatic within limit)..." [see at least col. 10, lines 43-45].

"...using preauthorization, the user may authorize the information interface provider to debit a preselected consumer account with respect to certain bills, typically recurring bills for the same amount, e.g., a mortgage payment" [see at least col. 4, lines 48-51].

As described in the disclosures above, it is clear that Ensel pertains to and teaches notifying a customer regarding typically recurring bills requiring payment which may be preauthorized or automatic. As such, the argument above as presented by Appellant is clearly taught by the cited reference. The limitation for the claim above as written, does not differentiate from the disclosure described above and is therefore interpreted broadly. The rejection with regard to the above argument with regard to Ensel should therefore be maintained accordingly.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section **(9)** above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) Reopen prosecution. Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) Maintain appeal. Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Art Unit: 3696

Respectfully submitted,

/Clifford Madamba/
Examiner, Art Unit 3696
30 January 2009

Conferees:

/THOMAS A DIXON/
Supervisory Patent Examiner, Art Unit 3696

/Vincent Millin/
Appeals Practice Specialist

Appeals Practice Specialist

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

/Wynn Coggins/
Director, TC 3600